

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-52 are pending. Claims 1-52 stand rejected.

Claims 1, 19, 31, 38-39, 43, 45-48, 50 and 52 have been amended. No claims have been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicant submits that the amendments do not add new matter.

Applicant reserves all rights with respect to the applicability of the Doctrine of Equivalents.

Claim 47 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2002/0064113 of Geeslin ("Geeslin").

Amended claim 47 reads as follows:

detecting a writable mark when scanning a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium; preventing modification to the re-writable paper that includes preventing from printing, by a peripheral device, a content in the non-electronic form on the re-writable paper that is the non-electronic medium in response to detecting the writable mark through the scanning the re-writable paper by a scanner.

(emphasis added)

Geeslin discloses setting the protection states to prevent access to the optical disc (paragraph [0005], Abstract). More specifically, Geeslin discloses that "the disk protection state restricts read and write access to the optical disc..." (paragraph [0028]). In particular, Geeslin discloses "when the optical disc is placed into a disc drive... the protection state byte... is read to ascertain that the optical disc... is currently in the write protection state." (paragraph [0032]).

Thus, Geeslin discloses preventing the access to the optical disc when the protection state byte is read when the optical disc is placed into a disc drive. In contrast,

amended claim 47 refers to preventing from printing, by a peripheral device, a content in the non-electronic form on the re-writable paper that is the non-electronic medium in response to detecting the writable mark through the scanning the re-writable paper by a scanner. Geeslin fails to disclose preventing modification to the re-writable paper that includes preventing from printing, by a peripheral device, a content in the non-electronic form on the re-writable paper that is the non-electronic medium in response to detecting the writable mark through scanning the re-writable paper by a scanner, as recited in amended claim 47.

Because Geeslin fails to disclose all limitations of amended claim 47, applicant respectfully submits that claim 47, as amended, is not anticipated by Geeslin under 35 U.S.C. § 102(b).

Claims 1, 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, 49, 50 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,867,821 of Ballantyne et al. (“Ballantyne”) in view of U.S. Patent No. 5,155,607 to Inoue et al., (“Inoue”).

Amended claim 1 reads, in parts, as follows: “creating a second collection of media objects from, at least in part, the first collection of media objects that includes scanning the first sheet to identify the first collection of media objects; and adding one or more media objects to the first collection of media objects that has been identified by scanning the first sheet that include at least one group of electronic documents; and re-marking the first sheet that includes printing a second graphical content representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects.”(emphasis added)

Ballantyne discloses displaying a graphical user interface which categorizes a user as a “patient” or as “ medical personnel.” (col. 9, lines 55-61). More specifically, Ballantyne discloses that “if the user has been classified as a “medical personnel”,.... the patient record information is retrieved,...[and] the patients record is modified...”(col. 10, lines 10-27). In particular, Ballantyne disclose updating the patient’s record through a health card writer device (col. 13, lines 10-27).

Thus, Ballantyne discloses updating the patient’s information that has been accessed through the graphical user interface using a writer device. In contrast, amended claim 1 refers to scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects that has been identified by scanning the first sheet. Ballantyne fails to disclose creating a second collection of media objects from, at least in part, the first collection of media objects that include at least one group of electronic documents that includes scanning the first sheet to identify the first collection of media objects; and adding one or more media objects to the first collection of media objects that has been identified by scanning the first sheet, as recited in amended claim 1.

Inoue, in contrast, discloses an optical modulation display device comprising a liquid crystal composition containing a photochromic compound (Abstract). Inoue fails to disclose creating a second collection of media objects from, at least in part, the first collection of media objects that include at least one group of electronic documents that includes scanning the first sheet to identify the first collection of media objects; and adding one or more media objects to the first collection of media objects that has been identified by scanning the first sheet, as recited in amended claim 1.

Furthermore, even if Inoue and Ballantyne were combined, such a combination would still lack creating a second collection of media objects from, at least in part, the first collection of media objects that include at least one group of electronic documents that includes scanning the first sheet to identify the first collection of media objects; and adding one or more media objects to the first collection of media objects that has been identified by scanning the first sheet, as recited in amended claim 1.

Therefore, applicant respectfully submits that claim 1, as amended, is not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Inoue.

Given that claims 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, 49, 50, and 52 contain the limitations that are similar to those limitations discussed above with respect to amended claim 1, applicant respectfully submits that claims 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, 49, 50, and 52 are not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Inoue.

Claim 46 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0052888 to Sellen et al. ("Sellen") in view of Inoue.

Amended claim 46 reads as follows:

A method comprising:

- determining whether a document is erasable that includes scanning a portion of the document to obtain first scanned data, wherein the portion of the document includes a content in a non-electronic form, wherein the document is a non-electronic medium;
- storing the first scanned data in a memory;
- performing, using a peripheral device, an erasing operation on the scanned portion of the document that includes the content in the non-electronic form at the location of the portion;
- scanning the portion of the document that has been subjected to the erasing operation to obtain second scanned data; and
- determining whether the non-electronic medium is erasable based on the first scanned data and the second scanned data.

(emphasis added)

Sellen discloses that the “scan-derived record identifier is used to access the respective current record and obtain the respective currently-stored version identifier. The scan-derived version identifier is compared with the currently-stored version identifier...”(Abstract). More specifically, the portions in Sellen cited by the Examiner (Figure 5) disclose that if the “update” of the stored file is required (step 84), the user is prompted to scan the content on the paper (step 86), and after the user scans the content on the paper at step 88, the user, at step 90 receives the content image. In particular, the passages in Sellen cited by the Examiner disclose that the current stored version of the document is printed (paragraph [0035]), the paper version of the document and the stored version of the document are compared to produce a revised document, and the current stored version of the document is replaced with the paper version.

Thus, Sellen discloses comparing the paper document with the stored document. In contrast, amended claim 46 requires scanning a portion of the document to obtain first scanned data; scanning the portion of the document that has been subjected to the erasing operation to obtain second scanned data, and determining whether the non-electronic medium is erasable based on the first scanned data and the second scanned data. Sellen fails to disclose aforementioned limitations, as recited in amended claim 46.

Inoue, in contrast, discloses an optical modulation display device comprising a liquid crystal composition containing a photochromic compound (Abstract). Inoue fails to disclose scanning a portion of the document to obtain first scanned data; scanning the portion of the document that has been subjected to the erasing operation to obtain second scanned data, and determining whether the non-electronic medium is erasable based on the first scanned data and the second scanned data, as recited in amended claim 46.

Therefore, applicant respectfully submits that claim 46, as amended, is not obvious under 35 U.S.C. § 103(a) over Sellen in view of Inoue.

Claims 2-8, 12, 13, 20-23, 27, 28, 32, 36, 39, 40, 42, 43, 45, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne in view of Inoue and in further view of U.S. Patent No. 6,396,598 of Kashiwagi et al. (“Kashiwagi”).

As set forth above, a combination of Ballantyne and Inoue fails to disclose creating a second collection of media objects from, at least in part, the first collection of media objects that include at least one group of electronic documents that includes scanning the first sheet to identify the first collection of media objects; and adding one or more media objects to the first collection of media objects that has been identified by scanning the first sheet, as recited in amended claim 1.

Kashiwagi, in contrast, discloses electronically acquiring an electronic memo to a document (Abstract). More specifically, Kashiwagi discloses “...specifying the document information and memo information necessary for memo addition/display process, based on an identifier added to document, read by scanner 62” (col. 11, lines 29-33).

Thus, Kashiwagi discloses the document identifier read by a scanner to associate a document with a memo. In contrast, amended claim 1 refers to scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects that has been identified by scanning the first sheet.

Furthermore, even if Inoue, Kashiwagi and Ballantyne were combined, such a combination would still lack scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects, wherein the first collection including at least one group of electronic documents has been identified by scanning the first sheet, as recited in amended claim 1.

Given that claims 2-8, 12, 13, 20-23, 27, 28, 32, 36, 43, 45, 48 contain the limitations that are similar to those limitations discussed with respect to amended claim 1, applicants respectfully submit that claims 2-8, 12, 13, 20-23, 27, 28, 32, 36, 43, 45, 48 are not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Inoue and further in view of Kashwagi.

Claims 11, 26, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne in view of Inoue and in further view of U.S. Patent No. 3,713,148 to Cardullo et al. ("Cardullo").

As set forth above, a combination of Ballantyne and Inoue fails to disclose scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects, wherein the first collection including at least one group of electronic documents has been identified by scanning the first sheet, as recited in amended claim 1.

Cardullo, in contrast, discloses a transponder. Cardullo fails to disclose, teach, or suggest creating a second collection of media objects from, at least in part, the first collection of media objects that includes scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects, wherein the first collection including at least one group of electronic documents has been identified by scanning the first sheet, as recited in amended claim 1.

Furthermore, even if Inoue, Cardullo and Ballantyne were combined, such a combination would still lack scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects, wherein the first collection including at least one group of

electronic documents has been identified by scanning the first sheet, as recited in amended claim 1.

Given that claims 11, 26, and 35 contain the limitations that are similar to those limitations discussed with respect to amended claim 1, applicants respectfully submit that claims 11, 26, and 35 are not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Inoue and in further view of Cardullo.

Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne in view of Inoue and in further view of U.S. Patent No. 6,260,063 to Ludtke et al. (“Ludtke”).

As set forth above, a combination of Ballantyne and Inoue fails to disclose scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects, wherein the first collection including at least one group of electronic documents has been identified by scanning the first sheet, as recited in amended claim 1.

Ludtke, in contrast, discloses object lists and object entries. Ludtke fails to disclose, teach, or suggest creating a second collection of media objects from, at least in part, the first collection of media objects that includes scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the first collection of media objects, wherein the first collection including at least one group of electronic documents has been identified by scanning the first sheet, as recited in amended claim 1.

Furthermore, even if Inoue, Ludtke and Ballantyne were combined, such a combination would still lack scanning the first sheet to identify the first collection of media objects that include at least one group of electronic documents; and adding one or more media objects to the



first collection of media objects, wherein the first collection including at least one group of electronic documents has been identified by scanning the first sheet, as recited in amended claim 1.

Given that claims 16-18 contain limitations that are similar to those limitations discussed with respect to amended claim 1, applicants respectfully submit that claims 16-18 are not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Inoue and further in view of Ludtke.

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne in view of Inoue and further in view of Sellen.

For at list the reasons that are similar to those reasons discussed above with respect to amended claims 46, and 50, applicants respectfully submit that claim 51 is not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Inoue and further in view of Sellen.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If the Examiner believes a telephone conference would expedite in the prosecution of the present application, the Examiner is invited to call the undersigned at (408) 720-8300.

If there are any additional charges, please charge Deposit Account No. 022666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: December 2, 2009

By: /Tatiana Rossin/  
Tatiana Rossin  
Reg. No. 56,833

1279 Oakmead Parkway  
Sunnyvale, California 94085-4040  
(408) 720-8300  
Customer No. 008791